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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,031	08/11/2000	Joseph G. Wirtz	1925.0050000	9611

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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,031

Applicant(s)

WIRTZ ET AL.

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3625

DETAILED ACTION

Election/Restrictions

Applicants' election of Group I (claims 1-12 and 20-25) without traverse received January 24, 2005 is hereby acknowledged. All other claims are hereby withdrawn from consideration.

Drawings

New corrected drawings are required because this application has been filed with informal drawings which are acceptable for examination purposes only. Applicant is advised to employ the services of a competent patent draftsman outside the Office. The corrected drawings are required in reply to the Office action. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

Claim 12 is objected to because of the following informalities: This claim recites the limitation "the global Internet." There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

USC 112 Sixth Paragraph Notification

Applicants have provided means-plus function language in claims 20-25 which could be construed as having a narrower meaning emanating from specific

Art Unit: 3625

embodiments found in the specification. Since it is the Applicants' responsibility to invoke USC 112 6th paragraph, the examiner will treat the claims using the broadest reasonable interpretation unless the Applicants respond to the office action invoking USC 112 6th paragraph and identifying the exact limitations that the Applicants are reading into the claims from the specification. Please be advised that should the Applicants invoke USC 112 6th paragraph in response to this office action the response may still be made final using the rationale that the Applicants have added new subject matter to the claims. A lack of response to this notice will be construed as prosecution history estoppel indicating that the Applicants does not wish to invoke USC 112 6th paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 12, 20, 22, 23, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al. (US Patent 6,029,141) hereafter referred to as Bezos.

Art Unit: 3625

Referring to claim 1: Bezos teaches a method of placing an electronic order from a data processing unit, comprising:

- receiving, at the data processing unit, a web page from a hosting web site during an interactive session between the data processing unit and a hosting server over a computer network, wherein said receiving a web page includes displaying the web page on a display unit in communications with the data processing unit, wherein said displaying the web page includes presenting one or more advertised products (col. 6, line 59 – col. 7, line 20; col. 11, lines 28-62; Figure 5, items “100” and “108”; Figure 6, item “120”; Abstract);
- receiving, at the data processing unit, a purchase request to purchase an advertised product (col. 2, line 47 – col. 3, line 7; col. 7, lines 30-34; col. 14, lines 38-51); and
- providing, by the data processing unit, an order form for the advertised product in response to the purchase request without having to exchange additional communications with the hosting server, wherein said providing an order form includes presenting the order form on the display unit, wherein the data processing unit remains connected to the hosting web site to continue the interactive session while a user operates an input device in communication with the data processing unit to complete the order form (col. 8, lines 17-26; Figure 10c; col. 15, lines 44-50).

Art Unit: 3625

Referring to claim 2: Bezos teaches all the limitations of claim 1 as noted above.

In addition, Bezos teaches processing, by the data processing unit, the order form in response to instructions from the user to send the order form to a merchant server to thereby produce the electronic order without having to exchange additional communications with the hosting server, wherein said processing the order form includes exchanging communications between the merchant server and the data processing unit over the computer network (col. 14, lines 38-51; col. 15, lines 44-50).

Referring to claim 12: Bezos teaches receiving a web page over the global Internet (Figure 1, item "104"; col. 6, lines 1-11).

Referring to claim 20: Claim 20 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 22: Bezos teaches computer code means to present descriptive information related to said advertised product in response to a descriptive information request, wherein said descriptive information includes an option to send purchase request (col. 7, lines 6-20).

Referring to claim 23: Claim 23 is rejected under the same rationale as set forth above in claim 2.

Referring to claim 25: Bezos teaches that the computer network includes the global Internet (Figure 1, item "104"; col. 6, lines 1-11).

Claim Rejections - 35 USC § 103

Art Unit: 3625

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent 6,029,141) in view of Official Notice.

Referring to claim 6: Bezos teaches all the limitations of claim 2 as noted above.

Bezos does not teach the step of confirming, by the processing unit, billing information entered into the order form by the user prior to sending the order form to the merchant server. However, Official Notice is taken that it is old and well known in the art to confirm a buyer's billing information prior to placing an order. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to ensure that the order was charged to the proper account.

Referring to claim 7: Bezos teaches all the limitations of claim 2 as noted above.

Bezos does not teach the step of encrypting the order form prior to sending the order form to the merchant server. However, Official Notice is taken that it is old and well known in the art to encrypt an order prior to sending the order to a merchant. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method of Bezos. One of ordinary skill in

Art Unit: 3625

the art would have been motivated to do so in order to use encryption to ensure the confidentiality and integrity of the order.

Referring to claim 21: Claim 21 is rejected under the same rationale as set forth above in claim 7.

Referring to claim 24: Claim 24 is rejected under the same rationale as set forth above in claim 6.

Claims 3-5, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent 6,029,141) in view of Hamel (US 2002/0007393 A1).

Referring to claims 3-5: Bezos teaches all the limitations of claim 2 as noted above. Bezos does not teach the step of receiving, at the data processing unit, a banner applet to implement at least one of said presenting one or more advertised products, said receiving a purchase request, said providing an order form, and said processing an order form. Bezos also does not teach receiving, at the banner applet, a request for descriptive information related to the advertised product prior to said receiving a purchase request; and providing, by the banner applet, the descriptive information, wherein the descriptive information is presented on the display unit and includes an option to send the purchase request in response to input from the user. Finally Bezos does not teach providing, by the banner applet, an authorization request to be presented on the display unit in response to the purchase request; and implementing said providing an order form step in response to the banner applet receiving affirmation of the authorization request. However, Hamel teaches a method

Art Unit: 3625

for browser-executed software wherein advertised products are presented in a web page using a banner applet (paragraphs [0075] and [0076]; Figure 1, items "132" and "135").

Furthermore, Hamel discloses that when a user selects an applet within a web page scripting programs cause the applet to be download to the client system which then performs various functions on the client computer (paragraph [0076]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a banner applet for performing various functions into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to perform processing on the user's terminal as taught by Hamel (paragraph [0076]).

Referring to claims 10 and 11: Bezos teaches all the limitations of claim 1 as noted above. Bezos does not teach presenting the web pages in a first and second window, or displaying, by the data processing unit, the advertised product in a banner located within the first window, the banner containing a link that is capable of being activated to send the purchase request. However, Hamel teaches a method for browser-executed software wherein advertised products are presented in a web page using a banner applet (paragraphs [0075] and [0076]; Figure 1, items "132" and "135"). Hamel also teaches that when a user selects Ad 123 within a web page (i.e. first window), another webpage is opened (i.e. a second window) (paragraph [0078]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a first and second window into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to allow a user to perform a "click-through" as taught by Hamel. The cited prior art does not teach

Art Unit: 3625

that the second window displays an order form. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving, providing, and presenting would be performed the same regardless of what content was displayed in the second window. The differences between the content of the Applicants' second window and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the second window of the cited prior art because such information does not functionally relate to the steps claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent 6,029,141).

Referring to claims 8 and 9: Bezos teaches all the limitations of claim 2 as noted above. Bezos does not explicitly disclose providing the merchant server as the hosting server, or operating the merchant server and the hosting server by an affiliate of a merchant that promotes the advertised product. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to have any arrangement in the setup of the merchant and hosting websites. Applicant has not

Art Unit: 3625

disclosed that this particular arrangement of websites provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with the arrangement taught by Bezos because Bezos uses a merchant website, a hosting website, and an affiliate of merchant that promotes the advertised product (Figure 1, items "100" and "106"; Abstract). Therefore, it would have been obvious to one of ordinary skill in this art to modify Bezos to obtain the invention as specified in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Naeem Haq', with a long horizontal flourish extending to the left.

Naeem Haq, Patent Examiner
Art Unit 3625

August 22, 2005